

2/13/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 11

HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Diamond Brands Incorporated

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Serial No. 75/476,026

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Paul M. Denk for Diamond Brands Incorporated.

Barney L. Charlon, Trademark Examining Attorney, Law Office  
105 (Thomas G. Howell, Managing Attorney).

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Before Simms, Wendel and Bottorff, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Diamond Brands Incorporated has filed an application  
to register the mark ROSE BUD for "safety matches."<sup>1</sup>

Registration has been finally refused under Section  
2(d) of the Trademark Act on the ground of likelihood of  
confusion with the mark ROSE BUD which is registered for  
"chewing tobacco."<sup>2</sup>

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<sup>1</sup> Serial No. 75/476,026, filed April 29, 1998, claiming first use  
dates of May 6, 1914 via a predecessor company.

<sup>2</sup> Registration No. 882,744, issued December 23, 1969, Section 8 &  
15 affidavits, first and second renewals.

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*<sup>3</sup> factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ 1209 (TTAB 1999).

The marks of applicant and registrant are identical. Both marks consist of the term ROSE BUD and both are presented in typed drawing form, permitting actual use in any format including the same format. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). As noted by the Examining Attorney, the term appears to be arbitrary as used with registrant's chewing tobacco and thus entitled to the full scope of protection. Applicant has offered no evidence to the contrary.

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<sup>3</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

This identity of marks brings into play the well-established principle that the greater the degree of similarity in the marks, the lesser the degree of similarity between the goods that is required to support a holding of likelihood of confusion. If the marks are the same, as is the case here, there need only be a viable relationship between the goods to support such a holding. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983) and the cases cited therein.

The respective goods are applicant's safety matches and registrant's chewing tobacco. The Examining Attorney maintains that these goods are related in that they are goods of the type which may emanate from a common source and are marketed in the same channels of trade. To support this position he has made of record copies of several third-party registrations which show that the same entities, many being tobacco or cigar companies, often market both chewing tobacco and other tobacco products and matches under a single mark.

Applicant insists that the goods are distinct, noting particularly that matches are marketed in a variety of places; that they may be either given away for advertising purposes or purchased for flame ignition purposes; and that matches and chewing tobacco are manufactured by different

industries. Although acknowledging that matches may be given away or sold at tobacco stores, applicant argues that purchasers of chewing tobacco have no need for matches and, even if they do use them for other purposes, chewing tobacco is a more costly item and would be selected with greater care.

As noted above, the only requirement is that a viable relationship exists between the goods of applicant and registrant. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

Applicant has admitted that the products of applicant and registrant may travel in the same channels of trade, in that both may be encountered by purchasers in a tobacco store. The Examining Attorney has produced more than adequate evidence to establish that tobacco products, including chewing tobacco, and matches are goods which may be marketed by, and accordingly emanate from, a single

entity. See *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). We find it highly likely that when purchasers in tobacco stores or other retail outlets for these products encounter both chewing tobacco and matches bearing the identical mark, ROSE BUD, these purchasers will assume a common origin for the two products. Even though the matches may have been manufactured by other than the tobacco goods producer, it would be a reasonable assumption on the part of purchasers that the tobacco producer is disseminating the matches bearing its mark as a promotional or accessory item. While the purchaser of chewing tobacco may exercise care in selection of the tobacco and may not need matches for use thereof, there is nothing to preclude this same person from assuming that the producer of the chewing tobacco is providing matches as an accessory item for other tobacco products. Accordingly, we find a sufficient relationship to exist between registrant's chewing tobacco and applicant's matches that use of the identical mark thereon would be likely to lead to confusion as to source.

Applicant further argues that consideration should be given to the facts that applicant, either directly or through its predecessors, has been using its mark since 1914; that a registration was issued to applicant's

predecessor in 1915, although inadvertently allowed to lapse in 1996; and that registrant's registration issued in 1969 despite the long existing registration to applicant. Applicant contends that it is not logical to now find applicant's mark unregistrable, when the Office in 1969 reached the opposite conclusion with respect to registrant's mark. Applicant also asserts that although registrant claims a date of first use of 1912, and thus there has been concurrent use of the marks for over eighty-five years, there have been no instances of actual confusion, at least to applicant's knowledge.

While there may have been many years of contemporaneous registration, we are not bound by the prior Examining Attorney's determination as to registrability. See *In re Perez*, 21 USPQ2d 1075 (TTAB 1991). If nothing else, we do not have the registration file before us and are unapprised as to the circumstances surrounding the issuance of registrant's registration in 1969.

As for the lack of actual confusion despite the many years of coexistence of the marks, we can only note that this factor can be given little weight because registrant has not had the opportunity to be heard from on this point. See *In re National Novice Hockey League Inc.*, 222 USPQ 638 (TTAB 1984). While evidence of long concurrent use without

either party being aware of any instances of actual confusion may be a significant factor in resolving likelihood of confusion in an inter partes case, the very nature of an ex parte case precludes application of similar probative value to the mere assertion by an applicant of the absence of actual confusion. See *In re Sieber & McIntyre, Inc.*, 192 USPQ 722 (TTAB 1976). Despite applicant's arguments to the contrary, a parallel cannot be drawn to *Barre-National Inc. v. Barr Laboratories Inc.*, 773 F. Supp. 735, 21 USPQ2d 1755 (D.N.J. 1991). That was an infringement case and the presidents of both parties had submitted affidavits that they knew of no instances of actual confusion in at least sixteen years of concurrent use of the marks. Here we have only the unverified assertions of applicant and of applicant alone as to the absence of confusion.

Accordingly, upon weighing all the relevant *du Pont* factors, we find confusion likely.

Decision: The refusal to register under Section 2(d) is affirmed.

**Ser No.** 75/476,026